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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Marchand et al.

Serial No.: 10/049,284 Group Art Unit: 1626

Filed: June 17, 2002 Examiner: J. Murphy

For: METHODS FOR PREPARING PERFLUORINATED [18 F]-RADIOLABELLED NITROIMIDAZOLE DERIVATIVES FOR CELLULAR HYPOXIA DETECTION

RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington, D. C. 20231

Sir: I, elected Gp

In response to the Requirement for Restriction mailed November 5, 2002, applicants hereby elect Group II. The requirement for restriction is respectfully traversed.

At the outset, it is noted that the Office Action, at page 3, lists claims 3 and 5-8 as drawn to methods of making, and thus in Group II. However, claim 3 is a compound claim, and it is thus submitted that this claim should properly be contained in Group I. It is believed that the Examiner has been misled by a typographical error in the preliminary amendment of February 11, 2002, in which the claims numbered 1, 2 and 3 were actually claims 3, 4 and 5. A comparison of the original claims, versus the preliminary amendment, makes it clear that the preliminary amendment misnumbered the claims therein. Clarification of the restriction requirement is therefore respectfully requested, in any subsequent Office Action.

The requirement for restriction is respectfully traversed.

The portion of the Office Action at pages 3 and 4 appears to base the propriety of the restriction requirement on the lack of a "special technical feature" due to the variety of compounds encompassed within the claims. First, it is submitted that this basis does not justify separation of the methods of making, such as in the elected group, from the compounds, nor the methods and compounds from the methods of using. Thus, it is submitted that, regardless of whether the compounds in the present claims represent different "inventions" under the law, it is submitted that the process of making of these compounds, and the process of using them, cannot properly be restricted therefrom.

For example, annex B of part 2 of the PCT administrative instructions as amended July 1,

1992, contained annex B, at page AI-53 of the MPEP states that the method for determining unity of invention "shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product . . ." the rule continues that the words "specially adapted" are "not intended to imply that the product could not also be manufactured by a different process."

Part 2 of annex B provides examples concerning unity of invention, and provides the following example as *having* unity of invention:

claim 1: a method of manufacturing chemical substance X.
claim 2: substance X.
claim 3: the use of substance X as an insecticide.

It can be seen that the present claims bear the same relationship as this example, and that unity of invention is present between the compounds, their method of making, and the methods of use. Thus, withdrawal of the requirement for restriction, inasmuch as it separates methods of Group II, and uses of Group VI, VIII and IX, from the compounds.

The restriction requirement is further respectfully traversed, inasmuch as it is applied to the compound claims of Groups I, III-V and VII. It is respectfully submitted that unity of invention, under so called "Markush practice," is present and that the compound claim should not be separated as they have been done in the present situation. The above noted portion of the annex to the MPEP sets forth the standard to be applied in intermediate/final product claims. The MPEP states that unity of invention shall be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(A) the intermediate and final products have the same essential structural element. in that:

(1) the basic chemical structures of the intermediate and the final products are the same, or

(2) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(B) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

It is submitted that this is met in the present situation, where, for example, the intermediate claims all the share the common feature of N-protection by an amido group and/or are phthalimides, e.g., in claims 10-17. Thus, at least groups III and IV should be maintained together. Similar considerations apply to the other groups of the restriction requirement.

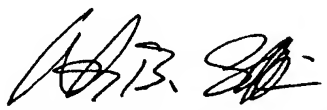
Moreover, it is submitted that various linking claims are present in the application, maintaining various other groups together without restriction. For example, claim 9 recites a compound obtainable by the method according to claim 5, while claim 20 recites an intermediate obtainable by steps a to i of the method of claim 7. Moreover, claim 22 recites a compound synthesized using as intermediates an intermediate of claim 10, an intermediate of claim 14, and an intermediate also of claim 10. It is submitted that these linking claims militate keeping all the groups together without restriction.

In view of the foregoing discussion, withdrawal of the restriction requirement is respectfully requested.

Should the Examiner have any questions or comments, she is cordially invited to telephone the undersigned at the number indicated below.

The Commissioner is hereby authorized to charge any fees under 37 CFR § 1.16 and § 1.17 which may be required to facilitate this filing, or credit any overpayment to Deposit Account #13-3402, two copies of this paper are attached for this purpose.

Respectfully submitted,



Harry B. Shubin, Reg. No. 32,004
Attorney/Agent for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Blvd. Suite 1400
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

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